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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,753	07/14/2006	Robert Mebruer	Q93258	6671
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EXAMINER				
UBER, NATHAN C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,753

Applicant(s)

MEBRUER, ROBERT

Examiner

NATHAN C. UBER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-856)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 16 March 2009.
2. Claims 1, 3 and 6 have been amended.
3. Claims 7, 9, 17-23 and 25 have been canceled.
4. Claims 1-6, 8, 10 and 11 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

5. The previous 112 2nd paragraph rejections are withdrawn because Applicant's amendments adequately traversed the rejection or Applicant's cancellation of a rejected claim rendered the rejection moot.

Claim Rejections - 35 USC § 101

6. The previous 101 rejection of claims 17, 18, 20-23 and 25 is moot because Applicant cancelled the claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 1-6, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millikan (U.S. 2003/0105667) in view of Avallone et al. (U.S. 2002/0147642) and in view of Sloane (U.S. 5,918,211).

Claim 1:

Millikan, as shown, discloses the following limitations:

- *a plurality of retail locations each having a detection device for detecting data uniquely related to consumer, in proximity to a location where merchandise is available to the detected consumer, without requiring interaction by the detected consumer (see at least ¶0024, "...a consumer detection and/or identification system...", "...the consumer does not need to do an activity to be detected by the system"),*
- *an output device for supplying a message specific to the individual detected consumer, providing specific offers available at the location to the individual detected consumer (see at least ¶0021, "...a plurality of message providers..." see also at least ¶0033, wireless devices for presentation of advertisements/offers to consumer, Examiner notes that the offers and advertisements presented by the Millikan invention are specific to the store/location see at least ¶0029, further Millikan discloses that "the message targeting system may perform its operation as described herein with respect to an individual consumer" see at least ¶0028),*
- *whereby the detected consumers is able to receive offers at the location without physical interaction on his or her part, and to avail himself or herself of the offers contained in the message supplied at the location (see at least ¶0026, "...system does not require active participation by the consumer..."),*
- *a first processor for generating a plurality of available offers and for identifying in a list specific offers in said plurality of offers that are applicable to a detected consumer based on data stored in a database relating to*

characteristics of the detected consumer, (see at least Figure 16, Item 20, see also at least ¶0029 generating targeted advertisements based on the characteristics of the customers identified/detected),

- *an Electronic Point of Sale (EPOS) terminal connected with the second server so that offers supplied by said message to a particular consumer are transmitted from the first server to the second server and then to the EPOS terminal so that when a consumer identifies himself or herself at the EPOS terminal, purchases made by the consumer are priced at the EPOS terminal in accordance with said offers specific to and previously supplied to that consumer (see at least ¶0027, "retail terminals... used to consummate retail or purchase transactions" and ¶0032, "during checkout at a retail terminal"),*

Millikan discloses a retail transaction terminal, but Millikan does not specifically disclose the common knowledge step of downloading coupon/special offer information to the retail transaction terminals so that a consumer that receives a special offer can actually obtain the offer. In a previous Office action Examiner took **Official Notice** that it is old and well known in the art to associate coupon and other customer incentive databases with a POS machine such that coupons are applied or downloaded to the POS for example upon swiping a customer/loyalty card. Further Examiner refers Applicant to the Sloane reference (U.S. 5,918,211) which teaches "[a] [r]etail computer/controller programmed to receive and store the promotional information sent by the retailer or sender, and can therefore offer the promotions at the appropriate time and to the appropriate consumer" (column 7, lines 22-26), and teaches sending targeted promotions to specific customers and immediately recording the discount at a computer/controller which is linked to the point of sale terminal that is additionally programmed to record shopping history and apply carry-over promotions to the order (column 8, lines 41-63). Examiner notes that the Sloane patent is directed primarily to a portable scanner that a consumer carries throughout a retail location. The Sloane scanner receives promotions targeted to the consumer and, as shown, it automatically applies the discounts offered to the consumer

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when the consumer selects the advertised product. Therefore this teaching of Sloane, albeit not necessarily the physical device of Sloane, is analogous to this invention and teaches the limitations which Applicant believes are not specifically taught by Millikan and Avallone.

Additionally Millikan does not specifically disclose multiple servers as in the limitations below, however, Avallone, as shown, does:

- *so that from the plurality of available offers, those specific offers, which relate to the detected consumer based on characteristics of the detected consumer are assembled for presentation as offers specific to the individual consumer (see at least ¶0054, portable display units receive personalized information for display to customers, see also at least ¶¶0094 and 0096, providing customer specific advertising and offers),*
- *the first processor comprises a first server for receiving the target file of offers (see at least ¶0059, "...the server's controller... enables the first server to access, read from, write to, and/or manipulate personalized information contained in one or more databases, communicate with a transmitter... communicate with one or more mainframe microprocessors... which are disposed locally or, more preferably, remotely from the commercial establishment"),*
- *a second server associated with the location being connected to the first server, and (see at least ¶0060, "[t]he second server communicates with the first server..."),*
- *a central station, comprising a second processor in communication with the first processor in each of said retail locations and operative to develop for each individual detected consumer a target file of said offers specific to the individual detected consumer and to provide said target file to at least said first processor (see at least ¶0059, "...the server's controller... enables the first server to access, read from, write to, and/or manipulate personalized*

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information contained in one or more databases, communicate with a transmitter... communicate with one or more mainframe microprocessors... which are disposed locally or, more preferable, remotely from the commercial establishment" and ¶¶0058 and 0061 describing the data contained in databases on the servers).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the targeted advertising system of Millikan with the old and well known technology disclosed by Avallone (networking capabilities, including multiple servers, remote and local servers) and with the old and well known advertising techniques of Sloane (including presenting offers to customers and processing transactions so that the customer receives the discount in the offer) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 2:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *said retail location is a retail outlet, a mall, a food court or an event area (see at least ¶0021, "...establishment... such as a retail store...").*

Claim 3:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitation:

- *the detection device comprises a Radio Frequency Identification Device (RFID) reader for reading an RFID tag carried by the consumer to identify a particular consumer (see at least ¶0024, "...detection... system may be a... field generator/detector that is operative to detect an identification card such as a transponder type card or a smart card...", RFID readers are Inherent to smart card and transponder technology).*

Claim 4:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitation:

- *the RFID tag can provide a unique code which provides a unique identification of an individual consumer so that individual consumers can be identified and distinguished from one another (see at least ¶0024, "...card may include the consumer information thereon, or provide consumer identification data...").*

Claim 5:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitation:

- *the RFID tag is contained in a card carried by the consumer (see at least ¶0024, "...an identification card such as a transponder type card or a smart card...").*

Claim 6:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Millikan, as shown, discloses the following limitations:

- *the output device comprises a transmitter (see at least ¶0027, "...a message generator and transmitter..."),*
- *for wireless transmission of the message to the individual consumer's mobile telephone or other portable receiver (see at least ¶0033, "...a wireless configuration... a PDA or the like...").*

Claim 8:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further Avallone, as shown, discloses the following limitation:

- *output device is a printer for printing a document containing the offer (see at least ¶0055, "... a printer for printing our, e.g., discount coupons..."),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the targeted advertising system of Millikan with the device of Avallone to allow customers to print desired ads or coupons because electronic devices such as cellular phones and PDAs have limitations such as memory or power that limit a customers accessibility to coupons provided thereon, a printing means helps a customer retain a coupon as well as free-up memory on his/her mobile device.

Claims 11:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Further, Millikan, as shown, discloses the following limitation:

- *the consumer identifies himself or herself by displaying the message to a person at the EPOS terminal, or by swiping a card which contains the user's identifying data at the EPOS terminal (see at least ¶0032, "...swiping of the customer card...").*

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Millikan (U.S. 2003/0105667) in view of Avallone et al. (U.S. 2002/0147642) and in view of Sloane (U.S. 5,918,211) and further in view of **Official Notice**.

Claim 10:

The combination Millikan/Avallone/Sloane discloses the limitations as shown in the rejection above. Millikan does not specifically disclose a retail server. However, Avallone, as shown, discloses the following limitation:

- *a retail server, comprising an inventory system and a consumer data base, in communication with each of said first processor and said second processor, and operative to provide price, inventory and consumer data for processing by said first and second processors (AVALONE ¶0061, server includes lists and databases of specials, promotional items, product locations, etcetera),*

Avallone does not specifically mention networking inventory databases to the POS. However, Examiner takes **Official Notice** that it is old and well known in the art to network inventory databases (such as those relying on the UPC bar code information for

product identification) with POS terminals in stores. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the targeted advertising system of Millikan with the networking capabilities, including multiple servers and remote servers, disclosed by Avallone and to further network a store inventory, POS and customer reward system because networking remote servers hosting common use databases (i.e. information that is not particular to a specific store) such as customer information databases and advertising storage with store specific databases and POS data (especially if they already exist in an establishment) present numerous efficiencies to the Millikan invention such as avoiding duplication of equipment and data, improving data accuracy and reducing system installation costs.

Response to Arguments

11. Applicant's arguments filed 16 March 2009 have been fully considered but they are not persuasive. Applicant argues primarily that the targeting feature of Applicant's invention is not disclosed by the prior art of record (see page 6 of Applicant's remarks). Examiner disagrees and directs Applicant's attention to at least ¶0028 of Millikan which discloses that "the message targeting system may perform its operation as described herein with respect to an individual consumer."
12. Applicant further argues that the prior art of record is different from the claimed invention because the prior art is not equipped to present individual offers to individual consumers on an individual basis without the use of special equipment. In fact with respect to this limitation, claim 1 is directed broadly to "an output device for supplying a message specific to the individual detected consumer..." The breadth of this claim language does not prohibit Examiner's interpretation of portable devices that receive specific advertising information such as wireless telephones or PDA's (as cited in at least Millikan ¶0033). In fact page 3, lines 21-23 of Applicant's specification discloses that "in one embodiment the output device comprises a transmitter for wireless transmission of the message to the individual consumer's mobile telephone or PDA."

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13. Applicant also asserts that in the claimed invention the pricing occurs at an EPOS terminal so there is no need for a consumer to carry a device to receive offers, but Applicant further asserts that the claimed invention allows "rewards to be offered prior to purchase." In fact claim 1 recites that the servers and EPOS terminals are connected and configured such that "when a consumer identifies himself or herself at the EPOS terminal, purchases made by the consumer are priced at the EPOS terminal in accordance with said offers specific to and previously supplied to that consumer" (emphasis added). Again the claim does not specifically define when or how ads are presented to consumers, but does clearly state that ads are presented to consumers prior to purchase and in fact prior to the consumer identifying him/herself at the EPOS. Examiner is left to look to the specification and the state of the art to determine how the offers and ads are presented to the consumer because this element of the invention is not specifically limited by the claim language. As noted in the rejection above, the prior art discloses several ways to transmit ads; ads are presented to the individual either over a loudspeaker, via a PDA or via a mobile device on the cart, a kiosk in the store or via the Sloan device. Therefore Applicant's argument that the claimed invention is narrowly defined such that the claims are novel and non-obvious over the several ad transmission methods of the prior art of record is not persuasive because claim 1 in fact does not specifically limit the ad transmission feature of the invention in the fashion Applicant asserts in Applicant's remarks.
14. Applicant further argues with respect to the Millikan reference individually that "Millikan does not envisage (1) assembly of a list of offers specific to one individual identified consumer and (2) transmission of that specific list of offers to that consumer only" (see page 6 of Applicant's remarks). This statement is false. As noted above, Millikan specifically notes in ¶0028 "the message targeting system may perform its operation as described herein [and Examiner notes here that ¶0033 discloses transmitting offers to individuals via individuals' PDAs] with respect to an individual consumer." Applicant further elaborates this argument by focusing on Millikan's detailed description of a preferred embodiment of ad transmission that presents the best ad based on the general population of the store. This is not persuasive because, as noted, the applicable disclosures of the Millikan reference on-which Examiner relies do not happen to

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include this feature of Millikan's preferred embodiment. Applicant then argues that Examiner mischaracterizes the claimed step of transmitting data to the EPOS. As noted in the rejection Examiner relied on a combination of references to teach this claim limitation because while some of the elements of this limitation are explicitly disclosed by Millikan, the Millikan reference does not specifically disclose the actual step of downloading offer data to the POS. Examiner's rejection however, clearly demonstrates where this offer download feature is demonstrated by Sloane and why the combination of teachings would have been obvious. Examiner does not agree with Applicant that Examiner mischaracterized any aspect of the limitation or that Examiner failed to demonstrate each aspect of the limitation in the prior art.

15. With respect to Applicant's argument against the Sloane reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant's argument (on page 8) is not persuasive because Applicant argues that the Sloane reference is deficient because it does not disclose aspects of Applicant's invention that are in fact taught by other references.
16. With respect to Applicant's argument against the Avallone reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant's argument (on page 8) is not persuasive because Applicant argues that the Avallone reference is deficient because it does not disclose aspects of Applicant's invention that are in fact taught by other references. Further Applicant falsely asserts that "Avallone does not remotely suggest the use of such technology to generate a list of specific offers applicable to specific detected customers..." In fact the stated purpose of the Avallone invention is "providing a user in a commercial establishment with personalized information, which can include... targeted advertisements..., promotional offers..., information on user specific favorite items..." (see the Abstract of Avallone).
17. As previously noted, applicant failed to traverse the examiner's assertions of official notice with respect to claim 10; therefore, the common knowledge or well-known in the art statements are

taken to be admitted prior art. To adequately traverse such a finding of official notice, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.") (MPEP 2144.03(c)).

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
20. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have

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questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at
866.217.9197 (toll-free).

22. Any response to this action should be mailed to:

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or faxed to **571-273-8300**.

23. Hand delivered responses should be brought to the **United States Patent and Trademark
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/Nathan C Uber/ Examiner, Art Unit 3622
2 July 2009

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622